



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/655,336 09/05/00 UEDA

T 1422-437P

EXAMINER

HM22/0320

BIRCH STEWART KOLASCH & BIRCH LLP
P.O. BOX 747
FALLS CHURCH VA 22040-0747

WANG, S

ART UNIT

PAPER NUMBER

1617

DATE MAILED:

03/20/01

Please find below and/or attached an Office communication concerning this application r proceeding.

Commissioner of Patents and Trademarks

BEST AVAILABLE COPY

Office Action Summary	Application No. 09/655,336	Applicant(s) UEDA ET AL	
	Examiner Shengjun Wang	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-18, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10 and 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8, 11, 16-18, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> | 20) <input type="checkbox"/> Other: _____ |

BEST AVAILABLE COPY

DETAILED ACTION

This application is a divisional application of application serial No. 09/403,486.

1. Applicant's election with traverse of invention Group I, claims 8-18 and 21-22, and species of premenstrual syndrome in Paper No. 6 submitted January 5, 2001 is acknowledged. The traversal is on the ground(s) that the search of all the inventions would not present undue burden to the examiner for search of all the inventions. This is not found persuasive because search of invention Group I is not required for search of invention Group II. Further, the search is not limited to patent literature.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 9-10, 12-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.
3. The claims have been examined insofar as they read on the elected species.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections 35 U.S.C. § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1617

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 8, 11, 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by applicants' own admission.

1. The specification on page 4, line 25 bridging page 5, line 4 disclose that theanine is a known major component in tea and are known to be used as food additive. The instant claims are drawn to a method comprising administering to women with PMS a composition comprising theanine. The composition herein read on tea and any other food containing theanine. Drinking tea has been a common and well-known practice in this country. The people who drink tea are reasonably expected to including at least some of the women with PMS. It is well-settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to *In re Swinehart*, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art."

Claim Rejections 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 1617

3. Claims 8, 11, 16-18 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' admission in view of Wu et al. (CAPLUS Abstract, AN 1994:556550) and Yokoyama et al. (CAPLUS Abstract, AN:388386).

4. The specification on page 4, line 25 bridging page 5, line 4 disclose that theanine is a known major component in tea and are known to be used as food additive. The instant claims are drawn to a method comprising administering to women with PMS a composition comprising theanine. The composition herein read on tea and any other food containing theanine. Drinking tea has been a common and well-known practice in this country. The people who drink tea are reasonably expected to including at least some of the women with PMS. It is well-settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art."

5. The inclusion of mineral in a tea composition is see to be obvious. Wu et al. teaches that minerals, such as zinc, are known to be closely related to the production of theanine in tea, therefore tea composition is reasonably expected to comprise some mineral components. See the abstract. Further, enrichment of a tea composition with well-known nutritional ingredients including minerals is considered within the skill of artisan. See, e.g., the abstract of Yokoyama.

6. Claims 8, 11, 16-18 and 21 -22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al. (JPAB Pub-No. JP406100442A) in view of Brown et al. (Medline Abstract, AN

Art Unit: 1617

94068973), Dinning et al. (Medline Abstract, AN 92357882) and Woods et al. (Medline Abstract, AN 97401022).

7. Fujii et al. teaches an antistress composition comprise theanine as the active ingredients. The composition may further comprise minerals. The composition may be in the form of soft drink. See the abstract.

8. Fujii et al. does not teach expressly to employ the said composition for suppressing or ameliorating premenstrual syndrome.

9. However, Brown et al., Dinning et al. and Woods et al. teach that stress is closely related to the severity levels of PMS. See the abstracts.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ Fujii's anti-stress composition for suppressing PMS.

A person of ordinary skill in the art would have been motivated to employ Fujii's anti-stress composition for suppressing PMS because the severity levels of PMS is closely related to stress. Any release of the stress would have been reasonably expected to be beneficial for suppressing PMS.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Application/Control Number: 09/655,336

Page 6

Art Unit: 1617


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

S. W. Wang

Shengjun Wang

AU 1617

March 16, 2001


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200